

B. Claim Amendment

Claims 4-5, 7-19, 21-30, and 32-33 have been canceled. Claims 1, 2, 3, 6, and 20 have been amended to define the present invention with more clarity in a form distinguishable from cited prior art references. New dependent Claims 34-40 have been added. Applicant respectfully submits that no new matter has been added in the current amendment.

C. Independent Claim 1, As Amended, Is Not Obvious over Hamlin in view of Hsieh, or Any Other Cited Reference.

Amended Claim 1 is not obvious over Hamlin or the other cited references because none of them discloses ‘at least two elongated straps’ extending perpendicularly between the side panels for supporting a shelf.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vacek*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §§ 2143-2143.03.

The amended claim 1 recites, in part, “at least two elongated straps extending between said side panels, each of said at least two straps being generally perpendicular to said side panels. ” Requiring such straps in a ‘perpendicular orientation’ with respect to the side panels for the purpose of providing ‘a support to the shelf,’ which must be disposed ‘generally perpendicular to the side walls is not disclosed in the prior art references. Indeed, none of the cited references teach or suggest use of even a single strip, much less two.

As understood by Applicant, Hamlin discloses a collapsible bag having a pair of elastic retainers 86 extending in a criss-cross configuration for retaining objects against the bottom panel 20. (Hamlin, col.2, ¶ 27). Notably, these retainers 86 are not designed to support objects therewith. Hamlin fails to provide any shelf or any other structure for dividing the compartment therewith. By contrast, the present invention disposes a pair of elongated straps perpendicular to the side panels 74 and 76 to support a shelf therewith. Applicant submits that the elastic retainers 86 are not only distinguishable from the straps in the present invention, but cannot be modified to support a shelf because it would frustrate a purpose of the Hamlin invention, which is to retain objects against the bottom panel.

As Applicant understands, Hsieh discloses a collapsible bag having reinforcing panels hingedly connected to walls. It discloses similar cross-shaped straps attached to the 'rear panel 28'. (Hsieh, FIG. 2). While these straps do extend perpendicularly with respect the side panels 38, the purpose of these straps, like Hamlin, are to merely retain objects against the rear panel, rather than support objects therewith. Further, there is no teaching or suggestion in Hsieh to use a shelf for dividing the inner compartment of the bag.

Yu discloses, as understood by Applicant, a backpack with a collapsible side wall and a plurality of semi-rigid dividers. Yu is distinguishable from the present invention because the semi-rigid dividers 35, 36, 37 are not supported by at least two straps as required by Claim 1, but by flexible fabric material 38 fixedly connected thereto. (Yu, Col. 4, lns. 15-19; *see also* FIGS. 4, 6, 7) In fact, the flexible fabric material 38 and the dividers 35, 36, 37 together define an integrated collapsible flexible file system 34 which is stitched to the 'back panel 12'. *Id.*

Since none of the cited references teaches or suggests the claimed element of "at least two

straps” and the structural limitation related thereto as discussed above, Applicant respectfully submits that independent amended Claim 1 is non-obvious over Hamlin, Hsieh, and in view of any other cited reference(s). For exactly the same reasons, the independent method claim 31, which requires the step of ‘providing a collapsible utility bag’ claimed in amended Claim 1, is non-obvious over the cited references. Also, in the respect that independent amended Claim 1 is believed to be non-obvious, its dependent Claims 2, 3, 6, 20, and 34-40 are also believed to be non-obvious.

D. Dependent Claims 2 and 20 Are Not Obvious over the Hamlin, Hsieh in view of Jenks.

The Jenks reference discloses a collapsible luggage box having a rectangular stiffening frame around the front opening of the box and the lid, which Hamlin and Hsieh fail to teach.

First, in the respect that independent Claim 1 is believed to be non-obvious over cited references as shown previously in section C, its dependent Claims 2 and 20 are also believed to be non-obvious.

Applicant submits that Claims 2 and 20 are also non-obvious on because there is no teaching, suggestion or motivation in Hamlin or Hsieh, either explicitly or implicitly, to modify the collapsible luggage piece in Hamlin or Hsieh to employ a peripheral rectangular frame following the teachings of Jenks. To combine or modify prior art references to produce the claimed invention in establishing a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves, the knowledge generally available to one of ordinary skill in the art, or the nature of problem to be solved. *See In re Dembiczak*, 175 F.3d 999, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); MPEP 2143. And the

express or implicit showing of such motivation, suggestion, or teaching must be based on particular findings related thereto, and broad conclusory statements standing alone are not evidence. *In re Dembiczak*, 175 F.3d at 999. As the Federal Circuit held, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 972 F.2d at 1783-84. Where the incentive to combine the teachings of the references is not readily apparent, it is the duty of the Examiner to explain why the combination of reference teachings is proper. *Ex Parte Skinner*, 2 USPQ 2d. 1788, 1790 (B.P.A.I. 1986).

As the motivation for such a modification, the Examiner recited, ‘to maintain the shape’ of the bags. The motivation cited by the Examiner, however, is not supported by any particular findings in either Hamlin or Hsieh. The Examiner failed to point out any particular portion in the cited references, whether in the specification or drawings, to substantiate the motivation he cited, ‘to maintain the shape.’ Nor did the Examiner identify any knowledge generally available to one of ordinary skill in the art, or the nature of problem to be solved so as to support such motivation. Applicant respectfully submits that the Examiner failed to meet the burden of establishing *prima facie* case of obviousness.

As understood by Applicant, neither Hamlin nor Hsieh discloses any desirability or need to provide further reinforcement means ‘for maintaining the shape’ of their bags. To the contrary, Hsieh appears to teach that no such reinforcement means is necessary. Hsieh discloses that strengthening panels are used not only on the side walls, but also on the front panel 30 and the rear panel 28 (respectively the door and the rear wall in Claim 1) to which ‘the claimed rectangular stiffening frames’ are supposedly connected. But Hsieh states that each of such panels includes “a

rigid, platelike rectangular member made out of strong material like a metal or a hard plastic, capable of providing strength to the collapsible wall structure” (emphasis added) (*See* Hsieh, Col. 4, lns. 18-21). It further states that “when the luggage piece **12** is in the erect configuration, each wall ... has an erecting panel rigidly attached and substantially parallel thereto to provide it with dimensional stability.” Applicant submits that the cited phrases mean that the door and the rear wall in Hsieh’s bag is already provided with strength and dimensional stability arising from the panel in the erect configuration. Being so, a person of ordinary skill in the art who is comprised of such explicit statement of Hsieh would be discouraged, rather than motivated, from modifying Hsieh’s invention to employ a further reinforcement means for maintaining its shape, such as the ‘rectangular frame’.

Similarly, in describing the six panels forming its box-shaped bag, Hamlin singles out only the four(top, bottom, inner, outer) side panels and states that these are “all of flexible material **27**, such as cloth, which is non-self-supporting or non-rigid.” (Hamlin, Par. [0022]). Applicant submits, such strongly implies that the remaining ‘top panel or the lid **18**’ and ‘the bottom panel **20**’ of Hamlin (corresponding to the door and the rear wall in Claim 1) is made of self-supporting, rigid material as distinguished from the other 4 side panels. If the top panel or the lid **18**’ and ‘the bottom panel **20**’ of Hamlin are made of such material, there would be no need of employing a further reinforcement means on them for maintaining its shape, such as the ‘rectangular frame,’ and therefore, a person of ordinary skill in the art comprised of Hamlin would not be motivated to do so.

For these reasons, Applicant respectfully submits that the motivation cited by the Examiner is at best a result of impermissible hindsight construction and cannot be sufficient legal basis to create obviousness under 35 U.S.C. 103(a), and that dependent Claims 2 and 20 should not deemed non-obvious over the cited references.